Docket No.: 07238/000J393-US0
(PATENT)
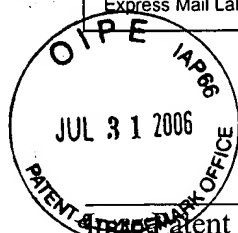
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Peter J. Stappers

Application No.: 09/879,247   Confirmation No.: 2263

Filed: June 7, 2001   Art Unit: 2173

For: METHOD AND ELECTRONIC DATABASE   Examiner: M. Roswell
      SEARCH ENGINE FOR DISCLOSING AN
      ELECTRONIC DATABASE

APPELLANT'S BRIEF ON APPEAL UNDER 37 C.F.R. § 41.37

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants submit this brief in accordance with 37 C.F.R. § 41.37 in support of their appeal from the Final Office Action, mailed March 30, 2006 by Examiner Michael Roswell, in the above-identified patent application.

This Appeal Brief is accompanied with a Notice of Appeal and a Request for One Month Extension of Time, along with the required fees. However, the Commissioner is hereby authorized to charge any unpaid fees deemed required in connection with this Appeal Brief, or to credit any overpayment, to Deposit Account No. 04-0100.

This brief is in support of said Notice of Appeal.

I.   REAL PARTY IN INTEREST

The real party in interest for this appeal is Technische Universiteit Delft, Netherlands. The inventors have assigned their rights in and to this application to Technische Universiteit Delft.

II.   RELATED APPEALS AND INTERFERENCES

To appellants' knowledge, there are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III.   STATUS OF CLAIMS

Claims 1-8 are pending in the application.

This appeal is in respect of the rejection of claims 1-8.

There are 8 claims pending in the application, and they are reproduced in the **Claims Appendix**. The current status of the application's claims is as follows:

1. Claims canceled: none;

2. Claims withdrawn from consideration but not canceled: none;

3. Claims pending: 1-8;

4. Claims allowed: none;

5. Claims rejected: 1-8.

Claims 1-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the non-patent literature *Interactive Layout Mechanisms for Image Database Retrieval*, John MacCuish, et al., SPIE 104-115, vol. 2656, January 1996 ("MacCuish"), in view of U.S. Patent No. 6,219,053 to Tachibana et al. ("Tachibana"), and in view of U.S. Patent No. 5,757,358 to Osga.

The claims on appeal are claims 1-8.

For the purpose of the present appeal, Appellants request that claims 1-8 be considered to form a single group.

IV.   STATUS OF AMENDMENTS

No amendments have been filed subsequent to the March 30, 2006 Final Office Action.

V.   SUMMARY OF CLAIMED SUBJECT MATTER

The claimed invention relates to an electronic database search engine and is directed to a system and method for providing a user interface for the database, where the user interface displays at least one element from the database on a display unit. The user interface allocates icons to the elements of the database, which icons are suitable for display on the display unit, and the icons are displayed at mutual distances that depend on the elements' degree of dissimilarity. A control means controls the user interface so that any arbitrary position can be selected on the display unit and the user interface displays or removes an icon that relates to an element of the database, and of which degree of dissimilarity, in respect to the elements whose corresponding icons are displayed elsewhere on the display unit, corresponds with the distance taken up by the selected position in relation to the icons displayed elsewhere on the display unit.

VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-8 can properly be rejected as obvious under 35 U.S.C. § 103(a) based on the combination of MacCuish, Tachibana, and Osga.

VII. ARGUMENT

The combination of MacCuish, Tachibana, and Osga results in a system that fails to have an icon appear at a position selected by a control means when there is an element in a database having a corresponding distance to database elements for which icons are already displayed elsewhere on the display unit.. Thus, combining MacCuish, Tachibana, and Osga does not result in the claimed invention.

The Examiner acknowledges MacCuish's narrow disclosure and that MacCuish fails to disclose "the control means to select a position on the display unit that upon selection displays or removes an icon related to a database element where its degree of dissimilarity to other icons corresponds with the distances between the icons." The Examiner further acknowledges that MacCuish fails to disclose "the mutual positioning of icons on the display in concurrence with the dissimilarity of the elements from the database in order to optimize the usable display area on the display unit." (Detailed Action, page 2.) The Examiner cites Tachibana (column 2, lines 42-52, and column 1, lines 1-5) as disclosing those features acknowledged to be missing from MacCuish.

However, the Examiner also acknowledges that the combination of MacCuish and Tachibana fails to disclose, or suggest, "the display or removal of an icon related to a database element upon the selection of an arbitrary position on the display." (Detailed Action, page 3.) The Examiner relies on Osga as disclosing "the selection and manipulation of an object on the display based on the selection of an arbitrary position by the user, based on the distance of a cursor to an object, as shown at col. 4, lines 40-53." (Detailed Action, page 3) The Examiner contends that it would have been obvious to a person of ordinary skill in the art to combine MacCuish, Tachibana, and Osga to achieve the invention of claims 1-8.

Appellant submits that Tachibana, column 2, lines 42-52, discloses an apparatus that draws icons corresponding to objects, where the correlation between objects is taken into account in computing the correlated positions of the icons. This passage describes in general terms the

embodiment of Tachibana, Fig. 4, which is explained at column 6, line 23-45. Column 6 clearly discloses that **Tachibana's user interface displays elements at varying distances based on their correlation from a root element.** Tachibana discloses displaying icons indicating hierarchical levels, where "the icon indicating the root of the first hierarchical level is a currently regarded node, and is positioned in the center . . . ." (Tachibana, column 6, lines 24-26.) Tachibana discloses that **the other icons are positioned relative to the icon which indicates "the root of the first hierarchical level."**

As recited in the claims, the present invention selects any <u>arbitrary position</u> on the display unit. Further, the user interface, depending on the control means, displays or removes an icon that relates to any possible element of the database of which the selected <u>arbitrary position</u> corresponds to the degree of dissimilarity with the other elements. In contrast to disclosing displaying an icon at any arbitrary position on the display unit, Tachibana discloses "an icon indicating the root of the first hierarchical level . . . positioned in the center" and that other icons are positioned relative to this root icon. Tachibana does not disclose, or suggest, "an arbitrary position . . . selected on the display unit" and the display of "the degree of dissimilarity, in respect of the elements whose corresponding icons are displayed elsewhere on the display unit," as recited in the present claims.

Appellant submits that the disclosure of Osga, column 4, lines 40-53, has no bearing on the patentability of independent claims 1 and 5. Osga in general is directed to determining if a cursor is located over a position on a display that corresponds to an object that a user wishes to select. Osga discloses a solution to the problem where a user must move his cursor to an object to be selected, estimate that the cursor appropriately overlaps the limited area directly over the object, and then must make a selection action. (Osga, column 1, lines 53-66.) Osga merely discloses a scheme to highlight an object that is closest to the actual cursor placement selected by the user.

In contrast, the present invention displays icons (which represent database elements) at positions **selected by a control means,** where the **distance of the icons on the display unit**
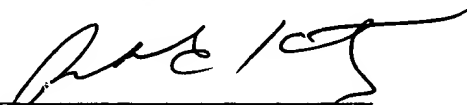
corresponds with the degree of dissimilarity of the database elements being represented. Claim 1 recites:

> [a] control means [that] selects any arbitrary position on the display unit and [a] user interface [that] displays or removes an icon that relates to an element of the database and of which the degree of dissimilarity, in respect of the elements whose corresponding icons are displayed elsewhere on the display unit, corresponds with the distance taken up by the selected position in relation to the icons displayed elsewhere on the display unit.

Under the present invention, an icon appears at the position selected by the control means when there is an element in the database having a corresponding distance to database elements for which icons are already displayed elsewhere on the display unit. Appellant submits that the present invention is significantly different than the system that results from the combination of MacCuish, Tachibana, and Osga. Thus, the combination of MacCuish, Tachibana, and Osga does not result in the claimed invention. Therefore, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness.

For all of the reasons set forth above, the rejections of claims 1-8 should be reversed. Appellants respectfully request that the application be remanded to the Primary Examiner with an instruction to withdraw the 35 U.S.C. § 103(a) rejections, and pass the case to allowance.

Respectfully submitted,

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APPENDIXES

CLAIMS APPENDIX

The following is a copy of the claims involved in the appeal:

1. (Previously Presented) An electronic database search engine comprising:

an electronic memory device suitable for storing and releasing elements from the database;

a display unit;

a user interface for selecting and displaying at least one element from the database on the display unit; and

control means for controlling the user interface;

wherein the user interface allocates icons to the elements of the database, and the icons are suitable for display on the display unit at mutual distances that depend on the elements' degree of dissimilarity, wherein the user interface at initial utilization displays at least some icons on the display unit, wherein the control means selects any arbitrary position on the display unit and depending on the control means, the user interface displays or removes an icon that relates to an element of the database and of which the degree of dissimilarity, in respect of the elements whose corresponding icons are displayed elsewhere on the display unit, corresponds with the distance taken up by the selected position in relation to the icons displayed elsewhere on the display unit.

2. (Original) An electronic database search engine according to claim 1, wherein the user interface adjusts the mutual positioning of the icons on the display unit in concurrence with the mutual dissimilarity of the elements from the database such as to concur with the displayed icons, in order to optimize the display area usable on the display unit.

3. (Previously Presented) An electronic database search engine according to claim 1, wherein the user interface provides means for placing a selected icon permanently in the center of the display unit, and arranging the remaining displayed icons.

4. (Original) An electronic database search engine according to claim 1, wherein to the elements of the database characteristics are added that are involved in determining the elements' degree of dissimilarity, and that the assessment of the dissimilarities between the various characteristics of the elements is adjustable.

5. (Original) A method for disclosing an electronic database using an electronic database search engine, comprising an electronic memory device, a display unit and a user interface for selecting and displaying at least one element from the database on the display unit, and further control means for controlling the user interface, which user interface allocates icons to the elements of the database, and at initial utilization displays at least some icons on the display unit at mutual distances that depend on the degree of dissimilarity of the elements of the database that are represented by said icons, wherein with the control means any arbitrary position can be selected on the display unit and in that, depending on the control means, the user interface displays or removes an icon that relates to an element of the database and of which the degree of dissimilarity, in respect of the elements whose corresponding icons are displayed elsewhere on the display unit, corresponds with the distance taken up by the selected position in relation to the icons displayed elsewhere on the display unit.

6. (Original) A method according to claim 5, wherein the user interface adjusts the mutual positioning of the icons on the display unit in concurrence with the mutual dissimilarity of the elements from the database such as to concur with the displayed icons, in order to optimize the display area usable on the display unit.

7. (Original) A method according to claim 5, wherein the user interface provides means for placing a selected icon permanently in the center of the display unit, while the remaining displayed icons are subsequently grouped around it.

8. (Original) A method according to claim 5, wherein to the elements of the database characteristics are added that are involved when determining the elements' degree of dissimilarity, and that the assessment of the dissimilarities between the various characteristics of the elements is adjustable.

EVIDENCE APPENDIX

All evidence is in the record.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings for this matter.